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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,152	10/06/2000	Sean Hu	PSTM0034/MRK	9961

29524 7590 07/06/2004

KHORSANDI PATENT LAW GROUP, A.L.C.
140 S. LAKE., SUITE 312
PASADENA, CA 91101-4710

EXAMINER

WEBB, JAMISUE A

ART UNIT PAPER NUMBER

3629

DATE MAILED: 07/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/684,152

Applicant(s)

HU ET AL.

Examiner

Jamisue A. Webb

Art Unit

3629

NW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 21-24, 36 and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 and 25-35 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6.9.10.11</u> . | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-20 and 25-35, drawn to a Computer system and method for printing a shipping label, classified in class 705, subclass 1.
 - II. Claims 21-24, 36 and 37, drawn to a Computer system and method for printing and scaling a graphical image, classified in class 358, subclass 1.2.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination discloses a method and apparatus for generating a shipping label, however does not require the particulars of the printing process such as creating a scalable character string. The subcombination has separate utility such as printing anything from a word document to photos; it does not require the printing of a shipping label.

3.

4. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 3629

5. During a telephone conversation with Marilyn Korsandy on 6/23/04 a provisional election was made without traverse to prosecute the invention of the computer system and method for printing a shipping label, Invention I, claims 1-20, and 25-35. Affirmation of this election must be made by applicant in replying to this Office action. Claims 21-24, 36 and 37 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Information Disclosure Statement

7. The declarations filed with the Information Disclosure Statement #9, filed 8/22/01, are not considered proper for IDS references. They have been reviewed and considered and placed in the file, however are not considered to be a "reference cited".

Specification

8. The use of the trademark UPS, USPS, FedEx, Mailboxes Etc., and Airborne Express has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Art Unit: 3629

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

9. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

10. Claims 2-4 and 25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

11. Claim 2 recites the limitation "the particular printer device" in line 5. There is insufficient antecedent basis for this limitation in the claim.

12. With respect to Claim 25: the phrase "generating a shipping according to" is indefinite. It is unclear to the examiner as to a shipping what? Is it a shipping label, a shipping manifest or some other kind of shipping document?

Claim Rejections - 35 USC § 102

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this

Art Unit: 3629

subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 1, 2, 4-6, 8-12, 14-16, 18-20, 26, 29-31 and 33-35 are rejected under 35

U.S.C. 102(e) as being anticipated by Kara (6,233,568).

15. With respect to Claims 1, 2, 4-6, 8, 10-12, 14-16, 18, 26, 29-31, 33 and 35: Kara discloses the use of a Shipping Management Computer System (see abstract) that is programmed to recognize a set of graphic resolution characteristics of a printer device (See Figure 6, and column 4, lines 49-54). Kara discloses the computer system used to create and generate a shipping label image bearing a dimensionally accurate symbology for display (See Figure 9). Kara also discloses the step of generating a shipping label according to a set of rules for a particular service of a particular carrier and according to the selection of the user (See Figures 6-9, column 5, lines 43-47, and column 6, lines 22-32). Kara discloses the users having a remote communication link such as the internet (See Claim 45), the examiner considers this to be a global communication link, since the internet can be accessed at any location across the globe. It is also the examiner's opinion that the system is for multiple users, therefore multiple printer devices.

16. With respect to Claims 8, 18 and 33: See Figures 8 and 9 with corresponding detailed descriptions, Column 6, lines 22-39.

17. With respect to Claims 9, 10, 19, 20, 34 and 35: See Reference numeral 710, column 19, line 66 to column 20, line 61.

Art Unit: 3629

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

20. Claims 3, 7, 13, 17, 25, 27, 28 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kara.

21. With respect to Claims 3, 7, 13, 17, 25, 27, 28: Kara, as disclosed above for Claim 1, discloses the use of a printing device, but fails to specifically disclose using a laser printer.

22. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to use a laser printer for generating the shipping labels because Applicant has not disclosed that using a laser printer provides an advantage, is used for a particular purpose or solves any stated problem. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with any

Art Unit: 3629

printer, whether it be a laser printer or an ink jet printer because they both provide the overall result of generating a shipping label.

23. With respect to Claims 7, 17, 25 and 32: Kara, as disclosed above for Claim 1, discloses the use of a Shipping Management Computer System, but fails disclose the use of sending a test image of the shipping label and requesting a response. It is old and well known in the art that this is done with all software programs that have a print preview option. It sends a test graphic to the screen, and the user must then push the "ok", "print" or "cancel" button. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to have the print preview option with Kara, in order for the user to see how the label will work once printed. This will also graphically resize the image to fit on the screen.

Conclusion

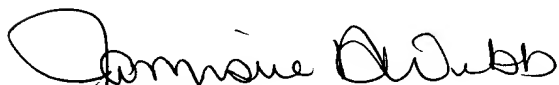
24. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kraemer et al. (5,491,637) discloses the use of a method of creating a label for pipe joints, Weber (5,787,400) discloses a method of creating shipping manifests, Brandien et al. (6,134,561) discloses the use of creating internal shipping labels, Sharp et al. (6,263,317) discloses the use of a web sales conflict resolutions system, Boucher et al. (6,078,889) discloses the use of a carrier manager librarian and Ramsden et al. (6,105,014) discloses the use of an automated shipping machine that prints out shipping labels.

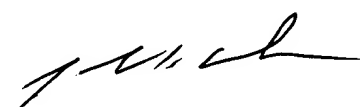
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jamisue A. Webb whose telephone number is (703) 308-8579. The examiner can normally be reached on M-F (7:30 - 4:00).

Art Unit: 3629

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (703) 308-2702. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jamiue Webb


JOHN G. WEISS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600